

REMARKS

The specification has been amended to correct reference to trademarks as required by the Examiner in co-pending application no: 11/291,426.

In the Communication dated February 28, 2007, the Examiner indicated that the Amendment and Response to Final Rejection Pursuant to 37 C.F.R. §1.116 filed on February 5, 2007 was not entered because the amendments contained therein “raise new issues that would require further consideration and/or search” and that “the amendment to the claims is non-compliant, since ‘allowable’ is not a proper status identifier.”

Applicants thank the Examiner for the courtesy of the telephonic interviews with Applicants’ representative, Deborah L. Nagle, on March 13 and 14, 2007 to clarify the Communication issued by the Examiner. In addition, Applicants gratefully acknowledge the Examiner’s indication during the telephonic interview that the Examiner would consider amendments to the claims to address the issues set forth in the Advisory Action.

Applicants respectfully submit that the amendments presented herein bring the claims into condition for allowance. In addition, Applicants submit that the status identifiers of the claims are compliant with U.S.P.T.O. Amendment and Response practice in that the word “allowable” has been deleted from the status identifiers of the claims.

Claims 1, 2, 4, 6, 8-12, 50, 51, 53-55, 57, 58, and 61-75, 78-84, and 87-112 were pending in this application. Claims 6, 50, 51, 53, 57, 65, 66, 90, 91, 92, 95 and 102 have been amended and claims 4 and 89 have been cancelled. In addition, the Examiner has indicated that claims 87-112 stand withdrawn from further consideration as being drawn to a non-elected invention. Accordingly, upon entry of this amendment, claims 1, 2, 6, 8-12, 50, 51, 53-55, 57, 58, 61-75, 78-84, 87, 88, and 90-112 will be pending.

Allowed Claims

The Examiner has indicated that claims 4, 6, and 53 are free of the art and that claims 1-2 and 8-12 are allowed.

Withdrawal of Certain Rejections

Applicants gratefully acknowledge the Examiner's indication that the following objections/rejections have been withdrawn:

the objection to the specification for lack of sequence compliance under C.F.R. § 1.821-1.825;

the rejection of claims 50 and 64 under 35 U.S.C. §112, second paragraph, as being indefinite for the recitation of "differentiating Thp cells and Th2 cells into Th1 cells";

the rejection of claim 58 under 35 U.S.C. §112, second paragraph, as being indefinite for the recitation of "comprising at least 700 nucleotides which is complementary to SEQ ID NO:1",

the rejection of claims 1, 2, 4, 6, 8-12, 50-51, 53-58, and 61-86 under 35 U.S.C. § 112, first paragraph, as it pertains to lack of written description for "complements";

the rejection of claims 54, 76, and 77 under 35 U.S.C. §112, first paragraph, new matter, for the recitation of "heterologous polypeptide."; and

the rejection of claims 1, 2, 8, 10, 51, 55, 58, 67, and 69 under 35 U.S.C. § 102(b) as being anticipated by Bulfone, *et al.* (1995) *Neuron* 15:63-78.

The Claim Amendments Should be Permitted

Support for the claim amendments presented herein may be found throughout the specification and claims, as originally filed, and/or as previously examined. Applicants submit that no additional search is required and no new issues have been raised by the amendments made herein. Furthermore, in view of the amendments, cancellations, and arguments set forth herein, the number of issues for appeal have been reduced. Specifically, Applicants submit that the claim amendments and cancellations presented herein obviate the Examiner's rejections under §112, first paragraph and §112, second paragraph.

No new matter has been added. Any amendment and/or cancellation of the claims should in no way be construed as an acquiescence to any of the Examiner's rejections and was

performed solely in the interest of expediting prosecution of the application. Applicants reserve the right to pursue the claims as originally filed in this or a separate application(s).

With respect to the introduction of the term “induces” into claims 6, 51, and 53, Applicants submit that as the generic term “modulates”, which embraces the terms “induces” and “reduces” has already been searched, it is Applicants understanding that the term “induces” will not require further search. Corresponding amendments have been made to claims 90-92 which were withdrawn subject to the non-allowance of generic linking claim 51.

With respect to amendment of claims 6, 51, and 53 to recite “induces IFN- γ production in CD4+ cells”, Applicants point out that this limitation was previously examined. In particular, Applicants point to previously examined claim 50, which recites “a nucleic acid molecule with at least 90% nucleotide identity with SEQ ID NO:1 over its full length, and which encodes a polypeptide that binds a consensus T-box site in DNA and modulates IFN- γ production, wherein the polypeptide has at least one activity selected from the group consisting of: inducing IFN- γ production in CD4+ cells, inducing Th1-associated cytokine production, inhibiting production of IL-2, and inducing the differentiation of Thp cells and Th2 cells into Th1 cells. A search of the T-bet variants previously examined in claim 50 would have identified art relevant to pending claim 6 which is directed to nucleic acid molecules with 90% nucleotide identity with SEQ ID NO:1 over the full length, wherein said nucleic acid molecules encode a polypeptide that binds to a consensus T-box site in DNA and induces IFN- γ production in CD4+ cells; claim 53 which is directed to nucleic acid molecules which encode a polypeptide comprising an amino acid sequence at least 95% identical to the amino acid sequence of SEQ ID NO:2 wherein said nucleic acid molecule encodes a polypeptide that binds to a consensus T-box site in DNA and induces IFN- γ production in CD4+ cells; and claim 51 which is directed to isolated nucleic acid molecules which hybridize to the complement of the nucleic acid molecule set forth in SEQ ID NO:1 over the full length of the isolated nucleic acid molecule in 6X SSC at 45°C, followed by one or more washes in 0.2X SSC, 0.1% SDS at 65°C under stringent conditions, and wherein said nucleic acid molecule encodes a polypeptide that binds to a consensus T-box site in DNA

and induces IFN- γ production in CD4+ cells. Corresponding amendments have been made to claims 90-92 which were withdrawn subject to the non-allowance of generic linking claim 51.

With respect to claim 57, Applicants submit that the amendments presented herein do not raise new issues and will not require further search.

In particular the Examiner is of the opinion that although

certain embodiments of nucleic acid molecules labeled with a detectable substance have been previously considered, the “nucleotide sequence shown in SEQ ID NO:1” labeled with a detectable substance is a new issue.

Claims directed to nucleic acid molecules comprising SEQ ID NO:1 have been found to be allowable (claim 2). Thus, claim 57 is narrower in scope than allowed claim 2. Accordingly, the amendment to claim 57 does not raise new issues that will require further search. A corresponding amendment was made to claim 102 which was withdrawn subject to the non-allowance of generic linking claim 51.

Based on all of the above, Applicants submit that the claim amendments made herein are permissible under 37 C.F.R. §1.116 as reducing the number of issues for appeal, and Applicants respectfully request that the instant Amendment be entered.

The Claim Amendments Overcome the Rejections of Record

Rejection of Claim 57 Under 35 U.S.C. § 112, First Paragraph

The Examiner has maintained the rejection of claim 57 under 35 U.S.C. § 112, first paragraph, “as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” “This is a new matter rejection.” More specifically, the Examiner is of the opinion that

claim 57, as amended, depends from claim 51, which recites an isolated nucleic acid molecule which hybridizes to the complement of SEQ ID NO: 1 over the full length. Therefore, the disclosure of labeled “probes” does not provide adequate support for the instant claim. Furthermore, the only recited examples of said probes are SEQ ID NO: 1 and 3, and the

instant claim is drawn a nucleic acid molecules that hybridizes to the "complement of" SEQ ID NO:1.

Applicants respectfully traverse the foregoing rejection for the reasons of record, however, without acquiescing to the validity of the Examiner's rejection and solely in the interest of expediting examination, Applicants have amended claim 57 such that it is directed to *isolated nucleic acid molecules comprising the nucleotide sequence shown in SEQ ID NO:1, wherein the nucleic acid molecule is labeled with a detectable substance*. As indicated by the Examiner, "the specification discloses labeled nucleic acid probes that hybridize to T-bet mRNA, including probes such as the T-bet DNA of SEQ ID NO: 1 or 3" (see, for example, the Office Action dated March 22, 2006, at page 4, seventh full paragraph). Accordingly, Applicants request reconsideration and withdrawal of this §112, first paragraph rejection of claim 57.

Rejection of Claim 4, 6, 50, 53, 64-75, and 78-84 Under 35 U.S.C. § 112, First Paragraph

The Examiner has maintained the rejection of claims 4, 6, 50, 53, 64-75, and 78-84 under 35 U.S.C. § 112, first paragraph, "as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention." More specifically, the Examiner is of the opinion that

there is insufficient written description to demonstrate that applicant was in possession of the claimed genus of nucleic acids that are "90% identical with SEQ ID NO:1", "encodes a polypeptide 95% identical to SEQ ID NO: 2", or "a fragment of at least 700 contiguous nucleotides of SEQ ID NO: 1".

The Examiner is further of the opinion that

[w]ith regard to claim 53, while the claim recites an isolated nucleic acid molecule which encodes a polypeptide with "95% identity", the recited function of said polypeptide is that it binds to a T-box site in DNA and "modulates" IFN- γ production. Therefore, the instant claims encompass a genus of nucleic acid molecules that are capable of "modulating" IFN- γ . For example, the claims might encompass nucleic acid molecules that can increase or decrease IFN- γ (i.e. "modulate"). The claims might even encompass nucleic acids that turn IFN- γ on or off, or those that result in intermittent modulation.

In contrast, *Applicant has only described nucleic acid molecules that induce IFN- γ production.* (Emphasis added).

With respect to claim 4, cancellation of this claim has rendered the Examiner's rejection moot. With respect to the Examiner's rejection to claims 6 and 53, and claims dependent therefrom, for the recitation of "modulates IFN- γ production", the amendments to the claims to recite "induces IFN- γ production" renders this portion of the Examiner's rejection moot.

With respect to the Examiner's rejection of claims 6 and 53, and claims dependent therefrom, for the recitation of nucleic acids that are "90% identical with SEQ ID NO:1" and "encodes a polypeptide 95% identical to SEQ ID NO: 2", respectively, Applicants respectfully traverse the aforementioned rejection for the reasons of record as well as the reasons set forth below.

Claim 6 is directed to isolated nucleic acid molecules which have at least **90% nucleotide identity with SEQ ID NO:1 over its full length, and which encode a polypeptide that binds a consensus T-box site in DNA and induces IFN- γ production in CD4+ cells.** Claim 53 is directed to isolated nucleic acid molecules which encode **a polypeptide comprising an amino acid sequence at least 95% identical to the amino acid sequence of SEQ ID NO:2, wherein said nucleic acid molecules encode a polypeptide that binds to a consensus T-box site in DNA and induces IFN- γ production in CD4+ cells.** Applicants respectfully submit that there is sufficient written description in Applicants' specification regarding the claimed nucleic acid molecules, to inform a skilled artisan that Applicants were in possession of the claimed invention at the time the application was filed, as required by section 112, first paragraph (see M.P.E.P. §2163.02).

As the Examiner is aware, the Federal Circuit has addressed the sufficiency of a disclosure in meeting the written description requirement of 35 U.S.C. §112 for claims to a genus of cDNAs. Specifically, the Federal Circuit stated that

[a] description of a genus of cDNAs may be achieved by means of a recitation of **a representative number of cDNAs, defined by nucleotide sequence, falling within the scope of the genus or a recitation of structural features common to the members of the genus, which features constitute a substantial portion of the genus** [emphasis added].

The Regents of the University of California v. Eli Lilly and Co., 43 USPQ2d 1398, 1406 (Fed. Cir. 1997). Accordingly, it is well settled that a claim to a genus of compounds satisfies the written description requirement if the specification *either* defines a representative number of its members falling within the scope of the genus by disclosing the sequence *or* if the specification defines the structural features common to a substantial portion of the genus. It is Applicant's position that the instant specification meets the written description requirements articulated by the Federal Circuit in Eli Lilly.

Applicants respectfully submit that the claimed genus of isolated nucleic acid molecules, which have at least 90% nucleotide identity with SEQ ID NO:1 over its full length, and which encode a polypeptide that binds a consensus T-box site in DNA and induces IFN- γ production in CD4+ cells and the claimed genus of nucleic acid molecules which encode a polypeptide comprising an amino acid sequence at least 95% identical to the amino acid sequence of SEQ ID NO:2, wherein said nucleic acid molecules encode a polypeptide that binds to a consensus T-box site in DNA and induces IFN- γ production in CD4+ cells are ***defined by structural and functional features that are described in the specification, recited in the claims, and commonly possessed by its members.***

In particular, *the structure of the claimed genus* is taught in the specification, *i.e.*, the sequence, of the nucleic acid molecules of the invention (SEQ ID NO:1) as well as the structure, *i.e.*, the sequence, of the polypeptide encoded by this nucleic acid molecule (SEQ ID NO:2). Applicants have also provided *functional features common to the claimed genus* of nucleic acid molecules, *i.e.*, the claimed nucleic acid molecules encode polypeptides that bind to a consensus T-box site in DNA and induce IFN- γ production in CD4+ cells.

Applicants further wish to point out that they have disclosed the amino acid sequence of human (SEQ ID NO:2) and murine (SEQ ID NO:4) T-bet polypeptides as well as the nucleotide sequence of human (SEQ ID NO:1) and murine (SEQ ID NO:3) T-bet nucleic acid molecules. In particular, the mouse T-bet nucleic acid molecule identified in Example 1 at page 62, line 28, through page 29, lines 1-25 was used to identify the human T-bet nucleic acid molecule. Human T-bet nucleic acid molecules share 85.7% nucleotide identity over their full length with murine T-bet nucleic acid molecules. Therefore, Applicants have disclosed a nucleic acid molecule

comprising a nucleotide sequence having slightly less than 90% nucleotide identity to SEQ ID NO:1 and a nucleic acid molecule comprising a nucleotide sequence having slightly less than 90% nucleotide identity to SEQ ID NO:3. (See, *e.g.*, Appendix A, submitted herewith, and Figures 1A-1B of the specification).

Furthermore, Applicants specification teaches methods routine to one of skill in the art to identify additional T-bet nucleic acid molecules (see, *e.g.*, page 15, line 34, through page 16, lines 1-17) and natural allelic variants of T-bet (see, *e.g.*, page 16, lines 27, through page 17, lines 1-5), and T-bet DNA sequence polymorphisms (see, *e.g.*, page 16, lines 18-26 of the specification).

Furthermore, both the human and murine T-bet nucleic acid molecules, even though they are slightly less than 90% identical to each other at the nucleotide level, encode polypeptides that have a specific function taught in the specification, recited in the claims, and commonly possessed by the members, *i.e.*, bind to a consensus T-box site in DNA and induce IFN- γ production in CD4⁺ cells.

Hence, Applicants should be entitled to claim nucleic acid molecules having an even higher percentage identity to the human and murine T-bet reference nucleic acid molecules with a specific function, *i.e.*, a polypeptide comprising an amino acid sequence at least 90% identical to SEQ ID NO:1 over its full length which encodes a polypeptide binds a consensus T-box site in DNA and induces IFN- γ production in CD4⁺ cells.

Similarly, with respect to T-bet polypeptides, since human T-bet polypeptides share 86.9% amino acid identity with murine T-bet polypeptides, Applicants have disclosed a polypeptide comprising an amino acid sequence having slightly less than 95% amino acid identity to SEQ ID NO:2 and to a polypeptide comprising an amino acid sequence having slightly less than 95% amino acid identity to SEQ ID NO:4. (See, *e.g.*, Appendix B, submitted herewith, and Figures 1C-1F of the specification).

In addition, the specification at, for example, page 28, lines 25-35, teaches domains that are conserved among members of T-bet polypeptide. For example, as indicated in the specification, the conserved domains and amino acid residues, *e.g.*, an amino-terminal portion of T-bet that includes a T-box domain at least amino acids 138-327 of human T-bet or at least amino acids 137-326 of mouse T-bet), a tyrosine phosphorylation site (amino acids 324-366

and/or 523-534 of human T-bet or amino acids 323-335 or 518-529 of murine T-bet), and a nuclear localization sequence (amino acids 498-501 of human T-bet or 493-496 of murine T-bet), are domains that may be present in T-bet polypeptides.

Applicants have also disclosed assays in the specification that one of skill in the art may use to test whether these T-bet polypeptides binds to and transactivate a T-box consensus site in DNA and induce IFN- γ production in CD4⁺ cells (see, *e.g.*, page 64, lines 15-35 and page 67, line 19, through page 68, lines 1-26 of the specification).

Furthermore, both human and murine T-bet, even though they are slightly less than 95% identical to each other at the amino acid level, have a specific function taught in the specification, recited in the claims, and commonly possessed by the members, *i.e.*, bind to a consensus T-box site in DNA and induce IFN- γ production in CD4⁺ cells.

Therefore, Applicants should be entitled to claim nucleic acid molecules which encode polypeptides having at least 95% identity to the human and murine T-bet reference nucleic acid molecules and amino acid sequences which encode a polypeptide that binds a consensus T-box site in DNA and induces IFN- γ production in CD4⁺ cells, since Applicants have demonstrated that polypeptides having 86.9% identity share this function.

Based on all of the foregoing, Applicants respectfully submit that there is sufficient written description in Applicants' specification regarding the claimed nucleic acid molecules and polypeptides encoded by such nucleic acid molecules, to inform a skilled artisan that Applicants were in possession of the claimed invention at the time the application was filed, as required by section 112, first paragraph (see M.P.E.P. §2163.02).

With respect to the Examiner's assertion that "claim 4 and 6 of the instant application are directed to a nucleic acid molecule that is '90% identical' with SEQ ID NO:1, and therefore do not meet the limitations of the written description guidelines cited by Applicant", Applicants respectfully submit that the 95% limitation recited in Example 14 of the *Revised Interim Written Description Guidelines Training Materials* is not meant to limit Applicants to nucleic acid molecules that are 95% identical, but rather serves as a guideline in establishing whether disclosure of ***a single species of nucleic acid molecules*** complies with the requirement of written description "through disclosure of relevant identifying characteristics, *i.e.*, structure,

other physical and/or chemical characteristics, functional characteristics when coupled with a known or disclosed correlation between function and structure, or some combination of such characteristics.” *Interim Guidelines for Examination of Patent Applications Under the 35 U.S.C. §112, First Paragraph Written Description Requirement.*

As discussed above, Applicants have provided such structural (*i.e.*, sequence) and functional characteristics. Furthermore, Applicants have identified nucleotide and amino acid differences in the disclosed murine and human sequences which maintain the required function and thus, have provided guidance as to which amino acid changes in the reference sequence may be made.

In further support of Applicants position that the *Revised Interim Written Description Guidelines Training Materials* are not meant to limit Applicants to nucleic acid molecules with 95% identity and a recited function, Applicants submit that the U. S. Patent Office has recognized that nucleic acid molecules with 90% identity and a recited function are patentable (see, for example, United States Patents 6,331,423, 6,818,427, and 6,664,077, attached as Appendices C, D, and E, respectively). Accordingly, the fact that the *Revised Interim Written Description Guidelines Training Materials* recites 95% nucleic acid identity does not in any way imply that the claimed nucleic acid molecules which have at least 90% nucleotide identity with SEQ ID NO:1 over its full length, and which encode a polypeptide that binds a consensus T-box site in DNA and induces IFN- γ production in CD4+ cells and/or nucleic acid molecules which encode a polypeptide comprising an amino acid sequence at least 95% identical to the amino acid sequence of SEQ ID NO:2, wherein said nucleic acid molecules encode a polypeptide that binds to a consensus T-box site in DNA and induces IFN- γ production in CD4+ cells are inadequately described.

Based on all of the above, Applicants submit that one of skill in the art would conclude that Applicants were in possession of the claimed invention at the time of filing and thus, Applicants have fulfilled the requirements of 35 U.S.C. § 112, first paragraph. Accordingly, Applicants respectfully request reconsideration and withdrawal of the foregoing rejection.

***Rejection of Claims 4, 6, 50-51, 53, 57, 64-75, and 78-84
Under 35 U.S.C. § 112, Second Paragraph***

The Examiner has rejected claims 4, 6, 50-51, 53, 57, 64-75, and 78-84 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular the Examiner is of the opinion that the claims “are indefinite in the recitation of a nucleic acid encoding a polypeptide that ‘modulates’ IFN- γ production.”

With respect to claim 4, cancellation of this claim has rendered the Examiner’s rejection moot. With respect to claims 6, 51, 53, and claims dependent therefrom, Applicants submit that the amendment to claims 6, 51, and 53 render the Examiner’s rejection moot. In particular, Applicants have amended claims 6, 51, and 53 to recite “***induces IFN- γ production in CD4+ cells***”. As indicated by the Examiner in sections 9 and 12 of the instant Office Action, Applicants have described “nucleic acid molecules that *induce* IFN- γ production” and that the instant specification discloses on page 14 that T-bet *induces* IFN- γ production.” Accordingly, Applicants request reconsideration and withdrawal of this §112, second paragraph rejection of claims 4, 6, 50-51, 53, 57, 64-75, and 78-84.

Rejection of Claims 4, 6, 50-51, 53, 57, 64-75, and 78-84

Under 35 U.S.C. § 112, First Paragraph

The Examiner has rejected claims 4, 6, 50-51, 53, 57, 64-75, and 78-84 under 35 U.S.C. §112, first paragraph, “as not contain[ing] a written description of the claimed invention.” “This is a new matter rejection.” In particular the Examiner is of the opinion that

[t]he instant specification does not disclose nucleic acid molecules encoding polypeptides that “modulate” IFN- γ , as now claimed.

With respect to claim 4, cancellation of this claim has rendered the Examiner’s rejection moot. With respect to claims 6, 51, 53, and claims dependent therefrom, Applicants submit that the amendment to claims 6, 51, and 53 render the Examiner’s rejection moot. In particular, Applicants have amended claims 6, 51, and 53 to recite “***induces IFN- γ production in CD4+ cells***”. As indicated by the Examiner in sections 9 and 12 of the instant Office Action, Applicants have described “nucleic acid molecules that *induce* IFN- γ production” and that the instant specification discloses on page 14 that T-bet *induces* IFN- γ production in CD4+ cells.”

Accordingly, Applicants request reconsideration and withdrawal of this §112, first paragraph rejection of claims 4, 6, 50-51, 53, 57, 64-75, and 78-84.

Rejection of Claims 4, 6, 50-51, 53, 57, 64-75, and 78-84

Under 35 U.S.C. § 112, First Paragraph

The Examiner has rejected claim 4, 6, 50-51, 53, 57, 64-75, 78-84 under 35 U.S.C. § 112, first paragraph because, according to the Examiner,

the specification, while being enabling for a polypeptide that has the activity of inducing IFN- γ production in CD4⁺ cells, does not reasonably provide enablement for a polypeptide that "modulates IFN- γ production".

With respect to claim 4, cancellation of this claim has rendered the Examiner's rejection moot. With respect to claims 6, 51, 53, and claims dependent therefrom, Applicants respectfully traverse the foregoing rejection and submit that one of ordinary skill in the art would be able to make and use the claimed invention using only routine experimentation. However, in an effort to expedite examination and in no way acquiescing to the Examiner's rejection, Applicants have amended claims 6, 51, 53. Specifically, claims 6, 51, 53 have been amended to "induces IFN- γ production in CD4⁺ cells". As indicated above, the Examiner has admitted that Applicants' specification is enabling for assaying the ability of the test compound to modulate a polypeptide that induces IFN- γ in CD4⁺ cells. Thus, this rejection as it pertains to claims 6, 50-51, 53, 57, 64-75, 78-84 has been rendered moot. Accordingly, Applicants request reconsideration and withdrawal of this §112, first paragraph rejection of claims 4, 6, 50-51, 53, 57, 64-75, and 78-84.

SUMMARY

In view of the above amendment, applicant believes the pending application is in condition for allowance. If a telephone conversation with Applicants' Attorney would expedite the prosecution of the above-identified application, the Examiner is urged to call Applicants' Attorney at (617) 227-7400.

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Respectfully submitted,

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